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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,954	09/07/1999	F. DEVON TAYLOR	112024-0051	7856
21186	7590	01/05/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			CUFF, MICHAEL A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/390,954

Applicant(s)

TAYLOR ET AL.

Examiner

Michael Cuff

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bennett et al.

Bennett et al. shows all of the limitations of the claims except for specifying that the accounting support services are external to and separate from the printer agent and the printer.

Bennett et al. shows, figures 7 and 8, a printing system with automatic statistical compilation and billing. There is a section, Statistical and Billing Information, in columns 5-8 which is of particular interest. The system described above may include several print jobs in memory (path, second print service) since jobs can be scanned at one time and then stored for subsequent printing. The system controller 7 (printer agent) can include a mechanism for identifying each account and counting the number of reprographic system functions performed for that specific print job (accounting support for print services, third print service). The system controller 7 can also store the billing rates for the various system functions for each account and calculate the billing cost for that account, as for example, the product of the rate for the printing function and the number of printing functions performed (tracking/evaluating). All information to be

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inputted into the controller 7 can be accomplished using the UI 52 (API). When a customer account has been deactivated by the system operator, requests to bill against the account will be denied. Printing jobs already in the printer queue that reference the account will be allowed to print, and will subsequently be billed to the account. A system operator can look at the print job summary or delete a print job with a deactivated account name. However, a new account name must be assigned to the original job in order to move or copy it (inherently, accept, reject, and hold functions are accomplished)

The examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art to make the elements separable if it were considered desirable for any reason to do so. The case law is from a mechanical background, but in the computer environment, it is desirable to make units modular or separable in order to facilitate programming and interface management. Also note that the Bennett et al. controller is already divided into many parts, (column 4, lines 19-23) it just does not specify the accounting.

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Bennett et al. system to separate, and thus apart, different functions in order to facilitate programming and interface management.

Response to Arguments

2. Applicant's arguments filed 9/8/05 have been fully considered but they are not persuasive.

In reference to applicant's argument, page 7, the 35 USC 112 rejection is withdrawn. Applicant's amendment removes the limitation of the accounting application 320 being external to the printer agent 330. Applicant asserts that the above components "are clearly separate and apart from one another" and "not integrated into a larger single application." The examiner concurs that the above components "separate and apart". However, the examiner does not necessarily concur that the above components are not integrated into a larger single application. Since this is not claimed, it will be addressed if it comes up in future prosecution.

Applicant has misstated the record that the examiner was unable to find "this" limitation. (Does "this refer to the former limitation or the current limitation?) Regardless, the examiner stated, see last office action, that the asserted difference was obvious, not an inability to find the "separate" limitation.

Applicant argues that the modularization modification would destroy Bennett if the Bennett system "was broken down and stored in multiple environments outside the printer" itself. This is not relevant because the applicant has removed the "external" or "outside" limitation. Therefore, it does not make sense to argue a scenario, which is not claimed.

Applicant argues that in reading Bennett, "separating features and functions to devices outside the printing system" would not be desirable. Again, applicant is arguing the limitation of "external", which is no longer part of the claim language.

Applicant argues that the examiner's interpretation is untenable. The examiner does not concur. See figure 2 of Bennett. The user interface 52 is "separate and apart" from system control 54 within the controller 7. This is much like applicant's figure 3 with applicant's accounting application 320 being "separate and apart" from printer agent 330 within the server 300. The examiner has already noted that the Bennett controller is already divided into many parts (column 4, lines 19-23). In reading the next paragraph, lines 24-45, one can see that the controller is made up of many separate Printed Wiring Boards (PWBs), which provide different functions. For example, image compressor/processor 51 is on PWB 70-3 or image manipulation is on PWB 70-6.

The Bennett system also states that the controller 7 can include a mechanism for accounting function, but the reference is silent as to how this mechanism is incorporated. The examiner does not believe that it would be unreasonable that one of ordinary skill in the art would put the accounting functions on a separate PWB, which is apart from the other PWBs.

Applicant asserts that the Official Notice has been traversed. The examiner believes that the above explanation is adequate. However, references Wong et al., Hughes, Deters, and Ladner et al. are provided as the first four of a large amount of references discussing modular technology in the computer field.

Applicant asserts that the examiner “tries to stretch the ordinary meaning of words, such as ‘separate and apart’ to suggest an indefiniteness problem”. The applicant has misstated the record, again. “and apart” was not even part of the record at the time of the last office action.

Applicant asserts that making Bennett modular would be contrary to Bennett's goals. This does not make sense because Bennett is modular, it just does not specify its accounting functions separately. This has been addressed above.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wong et al., Hughes, Deters, and Ladner et al. are cited for evidence of inherency.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 12/27/05
Michael Cuff
December 27, 2005